

REMARKS

Claims 1-17, 19 and 20 remain in this application. Claims 1-16, 19 and 20 are withdrawn from consideration. Claims 17 and 18 are rejected. Claim 18 is cancelled. Claim 17 is amended herein to address matters of form unrelated to substantive patentability issues.

Applicant herein traverses and respectfully requests reconsideration of the rejection of the claims cited in the above-referenced Office Action.

Claims 17 and 18 are rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. Claim 18 is cancelled, rendering its rejection moot. Applicant herein respectfully traverses this rejection as pertaining to claim 17.

The determination of enablement turns on whether the specification contains a sufficient disclosure to enable one skilled in the art to practice the claimed invention without the exercise of undue experimentation.

The above cited Office Action states that it is unclear why an animal would be relatively more likely to access the animal access region and relatively less likely to access an animal restricted region since an animal's actions are unpredictable. The plain answer, and one that is explained in great detail throughout the disclosure with

many examples and illustrations, is that the structure employed for the toy structure makes the animal's behavior, at least to some extent, predictable. Applicant reproduces below an excerpt from the disclosure directed to a broad explanation of how this predictable behavior is elicited.

Briefly stated, a dog toy is comprised of structure presenting regions providing different degrees of animal interest and/or accessibility, such that there is a higher likelihood that a dog will retain a particular part of the toy in its mouth apart from another region intended for grasping by the owner. A toy employing such concept will find application in various modes of play, including tug activities between dog and owner, throwing and retrieval, and any other type of interaction in which the toy is held by the dog in its mouth and is thereby subjected to a depositing of saliva over the particular involved region of the toy and later subject to transfer to a user's hand. For purposes of disclosure, a region of the structure of the toy which a dog is more likely to

bite and hold with its mouth by virtue of either enhanced sensory attraction and/or greater relative physical accessibility is referred to by the term “animal access region.” Conversely, a region or regions which are less likely to be accessed by the pet during play by reason of less sensory appeal and/or structural inaccessibility are referred to by the term “animal restricted region.” (See paragraph bridging pages 2 and 3)

Surely, the examiner could not argue, that if a toy were to be created by coating portions of a structure with strips of bacon to create an animal access region, and coating other parts of the structure with a bitter tasting substance having an unpleasant smell to form an animal restricted region, a dog would predictably grip the bacon-coated parts more frequently than the bitter-coated parts. Applicant respectfully submits that since such a hypothetical toy would lie within the contemplated scope of the invention, and could certainly be practiced by one of ordinary skill in the art without undue experimentation, the enablement requirement is satisfied.

The fact that the animal may bite the toy in areas other than the animal access region, as additionally averred by the Examiner, does not negate the invention nor make it non-enabled, since the method is directed to inhibiting user hand contact with animal saliva, not necessarily eliminating it entirely. All that is essential to practice of the claimed method is that gripping of the animal restricted region in the mouth of the animal occurs with less frequency than gripping of the animal access region in the mouth during the course of play, so that saliva buildup on the toy is relatively less in the hand-holdable animal restricted region than on the toy portion in the animal access region.

Applicant respectfully submits that one skilled in the art would readily be able to implement the present invention as claimed without undue experimentation based on a reading of the specification as filed. Therefore, reconsideration of the rejection claim 17 and its allowance are earnestly solicited.

Claims 17 and 18 are rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of informalities stated in the Office Action. Applicant respectfully traverses the rejection of claim 17 now remaining in the application after the cancellation of claim 18.

The subject of alleged unpredictability is discussed (and presumably dispelled) at length above with regard to the Section 112, first paragraph enablement

rejection. As noted, the specification is replete with description, example and illustration which make very clear how the claimed "animal restricted region" and "animal access region" respectively provide varying degrees of animal interest and/or physical accessibility to bring about predictable animal behavior such that one region is accessed more reliably than the other by the animal. It is well settled that the applicant may be his own lexicographer, defining his own terms in the specifications and claims, and that the claims must be interpreted in light of the specification. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 228 USPQ 90 (CAFC 1985). "If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is precise as the subject matter permits, the courts can demand no more." *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225 U.S.P.Q. 634, 641 (1985).

In the present instance, applicant, acting as his own lexicographer, gave the terms "animal restricted region" and "animal access region" used in the claims very specific, clear and definite meaning, as set forth for example, in the excerpt of the disclosure reproduced above for the Examiner's review.

Therefore, based upon the foregoing, reconsideration of the rejection of claim 17 and its allowance are respectfully solicited.

Claims 17 and 18 are rejected as obvious over O'Rourke (US 5,092,272) under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection.

For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

Applicant respectfully submits that the rejection fails to identify or discuss any teaching or suggestion in O'Rourke that would distinguish any region of the tug toy as being either "an animal access region" or an "animal restricted region" within the definition of such specially created terms. The Examiner fails to point to any specific disclosure in O'Rourke that teaches "a region of the structure of the toy which a dog is more likely to bite and hold with its mouth by virtue of either enhanced sensory attraction and/or greater relative physical accessibility" (i.e., the definition of "animal access region") or "a region or regions which are less likely to be accessed by the pet during play by reason of less sensory appeal and/or structural inaccessibility" (i.e., the definition of "animal restricted region").

To amplify a major distinction between the invention disclosed in O'Rourke and the invention of claim 17, if the tug in O'Rourke were to be picked up in a dog's mouth, unlike the present invention, the cited reference provides no indication whatsoever as to why there might be predictability as to what part the dog would choose to bite, since the reference fails to teach or suggest that any of the regions have more or less appeal/accessibility. Therefore, the claimed method could not be arrived at by a reading of O'Rourke, since O'Rourke lacks disclosure relating to

providing regions specifically intended to provide a predictable response from an animal picking the toy up in its mouth.

As such, applicant respectfully submits that O'Rourke fails to recite all claim limitations, as is properly required for establishing a *prima facie* case of obviousness. Thus, it is respectfully submitted that rejected claim 17 is not obvious in view of the cited reference for the reasons stated above. Reconsideration of the rejection of the claim 17 and its allowance are respectfully requested.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Lawrence I. Wechsler", written in a cursive style.

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